

### **REMARKS**

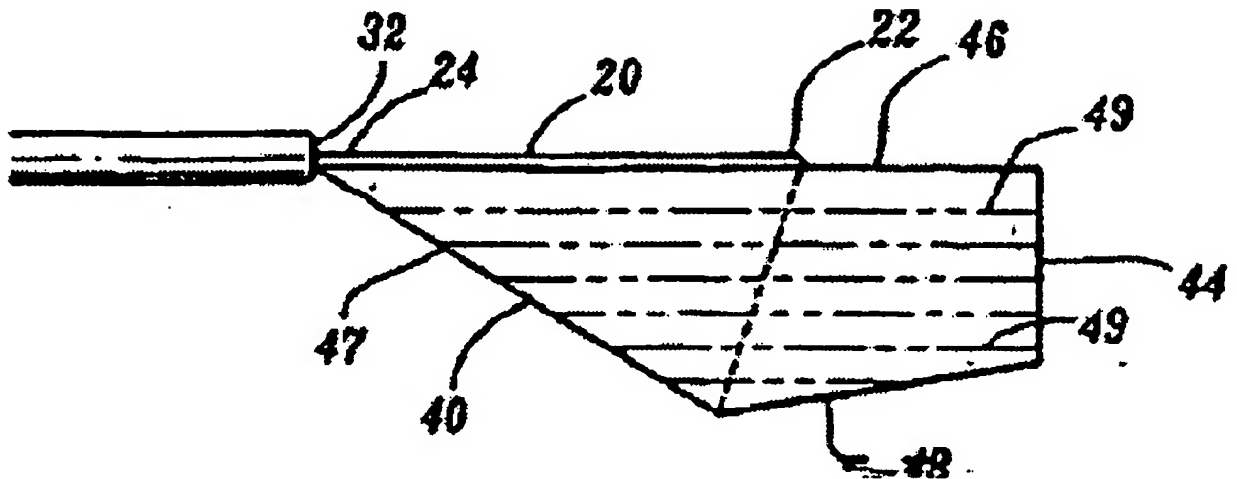
The present application has been reviewed in light of the Office Action dated October 16, 2006. Claims 1-32 are currently pending, of which, claim 31 has been amended herein.

Applicant submits that this amendment adds no new matter, is fully supported by the specification, and is allowable over the prior art of record. In light of this amendment and the remarks that follow, early and favorable reconsideration of this application is respectfully requested.

Claims 1-5, 7-9, 12-16 and 18-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,215,521 to Cochran et al. (hereinafter "Cochran") in view of U.S. Patent No. Re. 35,164 to Kindberg et al. (hereinafter "Kindberg"). Applicant respectfully submits that Cochran in view of Kindberg fails to disclose, teach, or suggest the minimally invasive tissue removal device recited in each of independent claims 1, 19, 28 and 31.

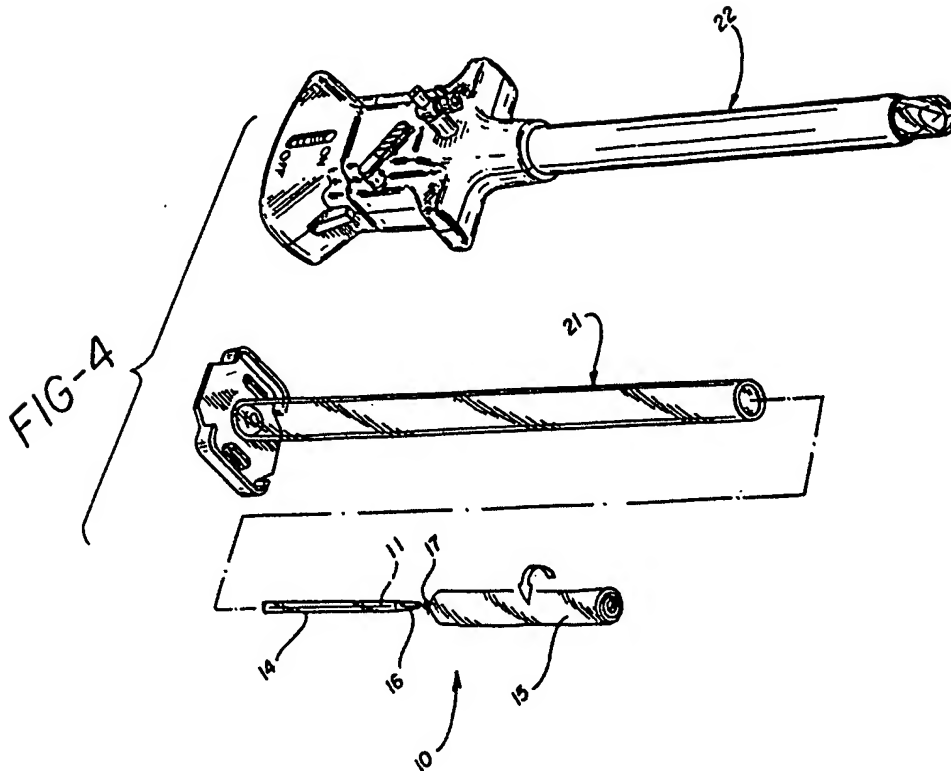
Independent claims 1, 19, and 28 each substantially recite, *inter alia*, a "bag having folds including at least one *transverse* fold". The specification states, as an example that to create a transverse fold "[b]ottom or second end 44 of bag 40 is bent or folded over on itself such that proximal folded edge 46 is approximately aligned and in apposition with bag support 20 and bottom end 44 is disposed so that bottom end 44 extends in a direction parallel with axis 'C'" which results in "a *transverse* fold 47 *running at an angle relative to longitudinal axis 'A'*", as seen below in FIG. 4 of the present application.

**FIG. 4**



Cochran, in contrast, discloses a tissue removal device and method comprising an elongate shaft, a collapsible bag support defining an expanded, open position and a closed, collapsed position, and a bag operatively attached thereto such that when the bag support is in the collapsed position, the bag is substantially closed.

Kindberg discloses a tissue removal device having a surgical bag folded about the longitudinal axis shared by the continuous filamentary strand and the tubular sleeve enclosing it, as seen in FIG. 4 below.



Under MPEP § 706.02(j):

“[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. ***Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.***” (Emphasis added).

The Office Action asserted that Cochran in view of Kindberg discloses a device including a bag having a transverse fold or folding a bag transversely with respect to the longitudinal axis.

In the Office Action, the Examiner asserts that “transverse” is defined as “acting, lying, or being

across: set crosswise” or “made at a right angle to the long axis of the body.” The Examiner then argues that Kindberg teaches each of these definitions of “transverse”. Applicant respectfully disagrees with the Examiner’s finding that Kindberg teaches a bag having a transverse fold and submits that the Examiner has mischaracterized the teachings of Kindberg.

At most, Cochran in view of Kindberg discloses a tissue removal device having a surgical bag that may be rolled about the longitudinal axis of the device, or about an axis parallel thereto, such that the folds created in the bag are *parallel* to the longitudinal axis of the device. In other words, the fold disclosed by Kindberg *runs parallel* to the longitudinal axis of that device (see, e.g., Fig. 5 of Kinderberg above). By contrast, claims 1 and 28 recite a bag with a transverse fold and claim 19 recites folding the bag transversely. Even accepting the Examiner’s definition of “transverse” (to which Applicants do not necessarily accede) as “acting, lying, or being across: set crosswise” or “made at a right angle to the long axis of the body,” Cochran in view of Kindberg fails to disclose or suggest a bag having a transverse fold as recited in claims 1 and 19 or folding the bag transversely as recited in claim 19. Accordingly, Applicant submits that Cochran in view of Kindberg fails to disclose, teach, or suggest each and every element and claim limitation set forth in independent claims 1, 19 and 28, as required by MPEP § 706.02(j).

Therefore, Applicant respectfully submits that independent claims 1, 19 and 28 are patentably distinguishable over Cochran in view of Kindberg, and therefore allowable under 35 U.S.C. § 103(a).

As claims 2-5, 7-9, 12-16, 18, and 20-30 depend, directly or indirectly from independent claims 1, 19 and 28, it is further submitted these claims are also allowable under 35 U.S.C. §

103(a) over Cochran in view of Kindberg.

As presently amended, independent claim 31 recites, *inter alia*, a “minimally invasive tissue removal device . . . comprising . . . an elongate shaft . . . defining a longitudinal axis . . . and . . . a bag . . . wherein the bag is folded over onto itself such that the ***axis of the fold is substantially non-parallel to the longitudinal axis of the shaft.***” (Emphasis Added).

As note above with respect to the discussion of claims 1, 19, and 28, Cochran in view of Kindberg fails to disclose, teach, or suggest a fold that is substantially ***non***-parallel to the longitudinal axis of the shaft. Accordingly, Applicant submits that Cochran in view of Kindberg fails to disclose, teach, or suggest each and every element and claim limitation set forth in amended independent claim 31, as required by MPEP § 706.02(j) under 35 U.S.C. § 103(a).

Therefore, Applicant respectfully submits that amended independent claim 31 is patentably distinguishable over Cochran in view of Kindberg, and therefore allowable under 35 U.S.C. § 103(a).

As claim 32 depends directly from claim 31, it is further submitted that claim 32 is in condition for allowance.

The Office Action also rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Cochran in view Kindberg and further in view of U.S. Patent No. 5,899,694 to Summer (hereinafter “Summer”). In the Office Action, it was argued that Summer discloses a sheath fabricated from a flexible heat-shrinking polymer. As discussed above, Cochran in view of Kindberg fails to disclose, teach, or suggest the “bag having folds including at least one transverse fold”, as recited in independent claim 1. The addition of the sheath disclosed in

Summer fails to cure this deficiency. Therefore, as claim 6 depends indirectly from claim 1, it is respectfully submitted that claim 6 allowable under 35 U.S.C. § 103(a) over Cochran in view of Kindberg.

Claims 10 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cochran in view Kindberg and further in view of U.S. Patent No. 6,402,722 to Snow (hereinafter "Snow"). In the Office Action, it was argued that Snow discloses a cord operatively connected to the tear line for facilitating the tearing of the sheath along the tear line. As previously discussed, Cochran in view of Kindberg fails to disclose, teach, or suggest the "bag having folds including at least one transverse fold" recited in independent claim 1. The addition of the cord disclosed in Snow fails to cure this deficiency. Therefore, as claims 10 and 11 depend indirectly from claim 1, it is respectfully submitted that these claims are in condition for allowance.

Claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Cochran in view Kindberg. As suggested above, Cochran in view of Kindberg fails to disclose, teach, or suggest the "bag having folds including at least one transverse fold" recited in independent claim 1. Therefore, as claim 17 depends directly from claim 1, it is respectfully submitted that this claim is allowable.

Should the Examiner believe that a telephone interview may facilitate prosecution of this application, the Examiner is respectfully requested to telephone Applicant's undersigned representative at the number indicated below.

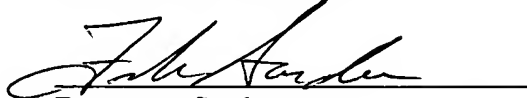
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Filing Date: September 16, 2004  
Docket: 2786 (203-3098 PCT US)  
Page 14 of 14

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Response to Office Action  
dated October 16, 2006

In view of the foregoing amendments and remarks, reconsideration of the application and allowance of claims 1-32 is earnestly solicited.

Respectfully submitted,



Francesco Sardone  
Reg. No. 47,918  
Attorney for Applicants(s)

**CARTER, DeLUCA, FARRELL & SCHMIDT, LLP**  
445 Broad Hollow Road, Suite 225  
Melville, New York 11747  
Phone: (631) 501-5700  
Fax: (631) 501-3526  
FS/nr